

REMARKS

Initially, Applicant is troubled by the prosecution of this application and requests immediate passage of this case to allowance *without further delay*. There have been 5 actions issued from the Examiner, and while Applicant had addressed the substance of each of those, prosecution is seemingly arbitrarily extended with little or no explanation or support.

The rejections and objections proffered in the present action with respect to the drawings and specification are without support and even a cursory review of the application provides direct, clear, and unambiguous support to the supposed deficiencies.

More importantly, while the Examiner has apparently withdrawn the improper art based rejections over Pedersen, the Examiner has now *reintroduced* the same rejection initially set forth in the very first office action dated April 1, 2008. This rejection was traversed and it was apparently withdrawn as the Final Rejection of December 2, 2009 introduced a new ground of rejection.

In the meantime, the claims have not been amended again. Thus, there is absolutely no basis to assert that the withdrawn rejection is somehow based upon a broadening of the claim language or a new or previously un-required interpretation of the reference.

Applicant must rely upon the good faith of the Examiner in properly conducting the prosecution and attempting to properly draw it to resolution. This includes properly vetting the application and references to *fully consider*, raise and address any and all potential issues in a timely manner. To withdraw a rejection, engage in 3 subsequent actions with a completely different ground of rejection, withdraw that rejection and *then reintroduce* the first *without so much as a comment or explanation* is, at the very least, unhelpful to prosecution. Almost two years of prosecution has resulted in the Examiner reissuing the initial rejection – a rejection that was successfully traversed - with minimal support provided in writing and absolutely no explanation as to the course of conduct. The time, money and effort expended by Applicant in diligently pursuing prosecution is largely and, unfortunately, permanently lost when pursuing such circular

examination. Applicant acknowledges that the law does not preclude the Examiner from reasserting a reference; however, such action is unusual and would warrant significant explanation particularly in this context.

In short, the very same reasons articulated in detail by the Applicant in the response dated August 29, 2008 continue to apply, continue to distinguish the claims from the reference, and at the very least should have been addressed in detail, in writing, and on the record by the Examiner. The Examiner's only response to these previously presented arguments *was to withdraw the rejection.*

Applicant hereby formally and explicitly requests an interview with the Examiner and the Examiner's supervisor, should the Examiner elect to issue any response other than a Notice of Allowance in response to this communication.

Response to Specific Issues

The Examiner requires new drawings in compliance with 37 CFR 1.121(d) "because the drawings are informal." This requirement is unsupportable and must be withdrawn.

I. INFORMAL DRAWINGS

The Office no longer considers drawings as formal or informal. Drawings are either acceptable or not acceptable. Drawings will be accepted by the Office of **>Patent Application Processing (OPAP)< if the drawings are readable and reproducible for publication purposes. See MPEP § 507.

MPEP 608.02(b)

The drawings are acceptable.

The Examiner next objects to the drawings for failing to show "the protruding part of the catheter element and the exclusion element." The rejection is unsupportable and must be withdrawn.

The Examiner is directed to page 11 of the specification, lines 32 -32. “The catheter element has a distal section with a protruding part (6).” Element (6) is illustrated in Figures 1, 5, 6, 7 and 8. The Examiner is next directed to page 12, lines 19 – 20. A “flange (12) adapted to exclude the protruding part.” The flange (12) is illustrated in Figures 5 and 6.

The objections must be withdrawn.

The Examiner rejects claims 4 -5, 15, and 17 under 35 USC 112, second paragraph. The assertion is that the language “protruding part, exclusion element with radially inwardly extending protrusion” is indefinite due to “not being defined explicitly in the specification or implicitly through its usage.” Applicant traverses.

As noted above, in one embodiment, the protruding part is element (6) which clearly shows an element that extends beyond the diameter of the catheter portion 9. The exclusion part (e.g., flange 12) narrows the compartment (9) so that when the protruding part (6) abuts the flange (12), the catheter (9) cannot be advanced further. The flange (12) may extend inwardly from the wall of the container towards the center. See Figure 5.

The rejection is unsupportable and must be withdrawn.

The pending claims were rejected under 35 USC 102(e) as being anticipated by Tanghoj et al. The rejection is unsupportable and must be withdrawn.

The rejection is unsupportable and improper for the same reasons articulated by Applicant in the response dated August 29, 2008 when the Examiner first proffered this rejection and later withdrew it; Applicant’s remark are incorporated by reference herein in their entirety.

The Examiner is further reminded that the reference must be read in its entirety. Tanghoj et al. disclose a number of distinct embodiments. There are two piece embodiments where a

sleeve/container (21) is separable from the catheter 20 and may be attached as a handle. There is a 3 piece embodiment (generally relied upon by the Examiner) that has a permanently affixed handle that telescopingly engages the catheter and a separable sleeve that covers the catheter and can be removed before use. This sleeve does not act as or form a handle; there is no interconnection of this sleeve to the distal end of the catheter.

It is improper for the Examiner to rely upon portions of the reference discussing a separable handle in a two-piece context and simply assert that they somehow apply to the three-piece context when clearly there is no teaching to do so or even the opportunity to do so. That is, why would one separate the sleeve, then remove the permanently attached handle and replace it with the sleeve to function as a handle?

Tanghoj is not an anticipatory reference as it does not teach all of the claimed elements when both the claim and the reference are considered as a whole; no more than a dictionary would be anticipatory because somewhere between the covers each element stated in the claim appears in the text.

To the extent the Examiner would consider asserting that Tanghoj under 35 USC 103(a) via 35 USC 102(e), Applicant would disagree on the merits but also point out that the reference would be disqualified under 35 USC 103(c).

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CONCLUSION

Applicant respectfully asserts that the pending claims are in condition for allowance and notice of the same is respectfully requested. Should any issues remain outstanding, the Examiner is respectfully urged to telephone the undersigned. No additional fee are believed due at this time; however, the office is authorized to charge any fees actually due and credit any overpayment to deposit account 50-4439.

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Respectfully submitted,
Pedersen et al.

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